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EXAMINER

WALLS, DIONNE A

ART UNIT PAPER NUMBER

1731

DATE MAILED: 08/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/755,031	CHADWICK, WILLIAM	
	Examiner	Art Unit	
	Dionne A. Walls	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-51 is/are pending in the application.
- 4a) Of the above claim(s) 11-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 43-51 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a breath freshening additive, does not reasonably provide enablement for such a breath freshening additive to be "the primary odor perceived upon exhalation". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. Clarification, or cancellation of the phrase in question, is requested.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 35-42, 44, 46, and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 35-42, the preamble of such claims is misleading. Applicant claims an "orally administered composition" but further describes such composition to include a "canister". Since, as read in light of the instant specification, the "canister" is *not* orally administered, and generally is not considered to belong to the "composition"

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statutory class, it is suggested that Applicant consider claiming the canister, in the preamble, in combination with the composition so that the claims are drawn to a product containing the listed "ingredients", as opposed to a "composition". Clarification and/or correction is requested.

5. Claims 44, 46 and 48 recite the limitation "said additive for diminishing the odor characteristics of tobacco". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 26-30, 34, 43-47, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 3140831 in view of Whitson-Fischman (US. Pat. No. 5,162,037).

DE 3140831 discloses all that is recited in the claims (Note: "sugar/powder" corresponds to the claimed "base ingredient"; "peppermint/mint/cloves" corresponds to the claimed "additive for diminishing the odor characteristics of tobacco"/ "breath freshening additive"/ "masking agent"; "menthol" corresponds to the claimed "additive for diminishing the odor characteristics of tobacco"/ "breath freshening additive"/ "antiseptic agent"; "powder" corresponds to the claimed "base ingredient....solid form"; see attached English abstract) except it may not explicitly state that the Plantago major component is in the form of a homeopathic preparation. However, Whitson-Fischman

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discloses that it is known to use homeopathic (i.e. extremely diluted) preparations of herbs, designed to be orally administered, for the treatment of addictive chemical dependencies (see col. 1, lines 15-49). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize a homeopathic preparation of *Plantago major* in the composition of DE 3140831 in order to receive the added benefits of a mixture prepared based on the art of homeopathy, disclosed in Whitson-Fischman, which focuses on the healing of persons with addictive dependencies. Also, while there may be no explicit articulation of whether the "menthol" (corresponding to the claimed "additive for diminishing the odor characteristic of tobacco") is provided in an "effective amount", the Examiner believes that the DE 3140831 reference satisfies this limitation. The phrase "effective amount" can mean different things to different observers, and without further-clarifying recitation reflecting a specific amount, or any similar language that can be found in the written disclosure, it is assumed that this limitation has obviously been met by the DE 3140831 reference, since menthol has been added in the amount of .21 weight%. Also, it follows that this claim limitation has been met since any addition of the menthol substance would also obviously be effective to diminish the odor characteristic, at least to some extent, even if it is negligible based on Applicant's standards.

8. Claims 26, 31-34, 43, and 48-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cody (US. Pat. No. 6,063,401) in view of Whitson-Fischman (US. Pat. No. 5,162,037).

Cody discloses all that is recited in the claims (Note: "liquid carriers/liquid core solvents" correspond to the claimed "base ingredient/liquid form"; "pill" corresponds to the claimed "solid form"; "citric acid" corresponds to the claimed "additive for diminishing the odor characteristics of tobacco"/ "neutralizing agent"; col. 2, lines 38-40; cols. 5 and 6) except it may not explicitly state that the *Plantago* major component is in the form of a homeopathic preparation. However, Whitson-Fischman discloses that it is known to use homeopathic (i.e. extremely diluted) preparations of herbs, designed to be orally administered, for the treatment of addictive chemical dependencies (see col. 1, lines 15-49). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize a homeopathic preparation of *Plantago* major in the composition of Cody in order to receive the added benefits that the art of homeopathy, as disclosed in Whitson-Fischman, has in the healing of persons with addictive dependencies. Also, while there may be no explicit articulation of whether the "citric acid" (corresponding to the claimed "additive for diminishing the odor characteristic of tobacco") is provided in an "effective amount", the Examiner believes that the Cody reference satisfies this limitation. The phrase "effective amount" can mean different things to different observers, and without further clarifying recitation reflecting a specific amount, or any similar language that can be found in the written disclosure, it is assumed that this limitation has obviously been met by the Cody reference, since the citric acid has to be added to the composition of Cody in an amount effective to serve its purpose. Also, it follows that this claim limitation has been met since any addition of citric acid would also obviously be effective to diminish the odor

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characteristic at least to some extent, even if it is negligible based on Applicant's standards.

9. Claims 26, 31-32, 34, 43, and 48-49 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitson-Fischman (US. Pat. No. 5,162,037) in view of Cody (US. Pat. No. 5,716,635).

Whitman-Fischman discloses a composition for the treatment of chemical dependencies in the form of a lollipop (corresponding to the claimed "base ingredient"/ "solid form"), upon which a homeopathic mixture of an herb and extract of citrus seed (corresponding to the claimed "additive for diminishing the odor characteristics of tobacco" / "neutralizing agent" / "citrus extract") is applied (col. 1, lines 15-21 and 47-49; col. 2, lines 33-34; col. 7, lines 33-44; col. 8, lines 52-54; see examples 1 and 24; see fig. 1). While Whitman-Fischman may not disclose that the homeopathic herbal mixture comprises *Plantago major* as its herb, Cody discloses in its "Background of the Invention" section that the herb *Plantago major* has been known as a tobacco deterrent for many years (col. 2, lines 63-65), and that the oral administration of *Plantago major* caused an aversion to tobacco in humans. Also, it is stated that various dilutions in ethanol and water of the herb has also been used orally (col. 3, lines 1-14). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to include *Plantago major* as an herb in the homeopathic mixture of Whitman-Fischman because, as taught in Cody, such herb, in dilute forms, is known for its benefits in encouraging a smoker's withdrawal from nicotine which is consistent with the goal of the composition in Whitson-Fischman – treating addictive dependencies using

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herbal mixtures. Also, while there may be no explicit articulation of whether the "extract of citrus seed" (corresponding to the claimed "additive for diminishing the odor characteristic of tobacco") is provided in an "effective amount", the Examiner believes that the Whitson-Fischman reference satisfies this limitation. The phrase "effective amount" can mean different things to different observers, and without further clarifying recitation reflecting a specific amount, or any similar language that can be found in the written disclosure, it is assumed that this limitation has obviously been met by the Whitson-Fischman reference, since the extract of citrus seed has to be added to the composition of Whitson-Fischman in an amount effective to serve its purpose. Also, it follows that this claim limitation has been met since any addition of extract of citrus seed would also obviously be effective to diminish the odor characteristic at least to some extent, even if it is negligible based on Applicant's standards.

10. Claims 35-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cody (US. Pat. No. 6,063,401) in view of Whitson-Fischman (US. Pat. No. 5,162,037), further in view of Rose et al (US. Pat. No. 4,953,572).

Cody discloses all that is recited in the claims (Note: "liquid carriers/liquid core solvents" correspond to the claimed "base ingredient/liquid form"; "pill" corresponds to the claimed "solid form"; "citric acid" corresponds to the claimed "additive for diminishing the odor characteristics of tobacco"/ "neutralizing agent"; col. 2, lines 38-40; cols. 5 and 6) except it may not explicitly state that the Plantago major component is in the form of a homeopathic preparation. However, Whitson-Fischman discloses that it is known to use homeopathic (i.e. extremely diluted) preparations of herbs, designed to be

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orally administered, for the treatment of addictive chemical dependencies (see col. 1, lines 15-49). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize a homeopathic preparation of *Plantago major* in the composition of Cody in order to receive the added benefits that the art of homeopathy, as disclosed in Whitson-Fischman, has in the healing of persons with addictive dependencies. Also, while there may be no explicit articulation of whether the "citric acid" (corresponding to the claimed "additive for diminishing the odor characteristic of tobacco") is provided in an "effective amount", the Examiner believes that the Cody reference satisfies this limitation. The phrase "effective amount" can mean different things to different observers, and without further clarifying recitation reflecting a specific amount, or any similar language that can be found in the written disclosure, it is assumed that this limitation has obviously been met by the Cody reference, since the citric acid has to be added to the composition of Cody in an amount effective to serve its purpose. Also, it follows that this claim limitation has been met since any addition of citric acid would also obviously be effective to diminish the odor characteristic at least to some extent, even if it is negligible based on Applicant's standards.

While Cody modified by Whitson-Fischman may not disclose its composition in combination with a spray canister, Cody does state that, as is known in the art, pharmaceutical compositions may be dispersed by numerous methods (see col. 3, lines 13-15). Also, Cody states that the composition can be administered in many forms, and is not limited to those suggested in the reference (See col. 5, lines 17-20). Further,

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Rose et al discloses a means for dispensing a medicament to assist those wishing to reduce the incidence of tobacco smoking, which comprises a nebulizer (corresponding to the claimed "spray canister") from which an aerosolized liquid is sprayed into the mouth of the user (see abstract and figs.). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to place the composition of Cody modified by Whitson-Fischman into a nebulizer, such as the one disclosed in Rose et al, since using such spray means is known, in the art, as an effective means for dispensing medication to individuals desiring to end their smoking habit.

Response to Arguments

11. Applicant's arguments filed on July 19th, 2003 have been fully considered but they are not persuasive.

- Applicant argues that while DE 3140831 modified by Whitson-Fischman may teach that its composition may contain flavoring agents, there is not teaching that these flavoring agents are suited for freshening the breath of a human or diminishing the odor characteristic of tobacco. Also, Applicant argues that in the Cody reference, citric acid is used as a preservative, not as an odor-diminishing additive. However, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

- Applicant argues that the DE 3140831 reference gives no indications that the herbal extract remedy of its invention is suitable for homeopathic remedy, and that the

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Whitson-Fischman reference does not teach of homeopathic preparations to treat chemical dependencies. While, Examiner does not agree with Applicant's assertions, she admits that neither reference anticipates the claims. However, the Examiner contends that the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The Examiner contends, as asserted above in the prior art rejections, that one having ordinary skill in the art would have been motivated to create a homeopathic herbal remedy out of the extract of DE 3140831 based on the teachings of Whitson-Fischman because the latter reference teaches the benefits of such preparation, especially when utilizing herbs in the treatment of addictive dependencies.

- Any other arguments that may not have been discussed have been adequately addressed in the above rejections over the prior art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

Dionne A. Walls
August 21, 2003